

REMARKS

Applicants submit these remarks in response to the Office Action dated March 31, 2004. Claims 20, 21-30 and 34-35 are pending in the present application, and claims 20, 28 and 34 are amended. Claims 41-45 contain the subject matter of previously cancelled claims 36-40. Applicants have responded to the issues raised in the Office Action in paragraphs that correspond to the paragraphs in the Office Action. No new matter is added.

Before addressing the Office Action, applicants wish to review the recent prosecution history, and respectfully request that the Examiner reinstate the previous allowance of claims 20-30. In the Advisory Action dated December 24, 2003, the Examiner indicated that claims 20-30 were allowed. Claims 36-40 were rejected under 35 U.S.C. § 112, first paragraph. Solely to advance the prosecution and to allow claims 20-30 to proceed to issue, applicants filed an amendment under 37 C.F.R. § 1.116 canceling claims 36-40, and a Request for Continued Examination, on February 5, 2004. Based on the recent prosecution history and the indication of allowed claims in the Advisory Action, applicants anticipated that the Examiner would issue a Notice of Allowance for previously allowed claims 20-30. Instead, the Examiner has issued a new Office Action and has raised new grounds of rejection as follows: claims 20-25 are rejected under 35 U.S.C. § 112, first paragraph; claims 20-30 and 34-35 are rejected under 35 U.S.C. § 112, second paragraph; and claims 21-27, 29-30 and 35 are rejected under 35 U.S.C. § 102(b). The Office Action contains no explanation of why the previous allowance of claims 20-30 has been removed.

Because the previous amendment (dated February 5, 2004) was filed solely in order to obtain issuance of a patent for the already allowed subject matter, applicants have re-presented cancelled claims 36-40 as new claims 41-45. Applicants submit that the previous grounds of rejection of claims 36-40 (now claims 41-45) cannot stand. Specifically, the Examiner stated that the term "moderate stringency" is indefinite, and that in view of this alleged indefiniteness, the genus of nucleic acids encompassed by the claim scope is not enabled, and the sequences do not meet the written description requirement. The Examiner stated that even a single amino acid change can alter the functional properties of a protein molecule. Applicants respectfully submit that the claims specifically recite that the claimed oligonucleotide is capable of hybridizing to a nucleic acid encoding a polypeptide comprising SEQ ID NO:3 or SEQ ID NO:6. The claim does not recite that the claimed oligonucleotide encodes SEQ ID NO:3 or SEQ ID NO:6. Alterations

in amino acid sequence are not recited. If a nucleic acid has "different properties from those described in the specification" (as stated by the Examiner in the Advisory Action) such that a protein that does not comprise SEQ ID NO:3 or SEQ ID NO:6 is encoded, that is not the determining feature of the claimed oligonucleotide. Instead, the relevant feature is its ability to hybridize to a specified sequence under conditions of moderate stringency. "Moderate stringency" is clearly defined in the specification, for example at page 10, lines 1-5. In view of the above, applicants respectfully submit that claims 41-45 are not subject to the grounds of rejection of previous claims 36-40.

Turning now to the Office Action dated March 31, 2004, the new grounds of rejection are addressed below, and applicants request that the Examiner explain why these rejections have been newly raised against claims that were allowed. The Office Action dated March 31, 2004 provided no rationale for these rejections of claims that had been allowed only three months earlier.

2a. The Examiner indicated that the title of the invention is not descriptive and required a new title. The title is amended herein to read, "Polynucleotides Encoding Epithelium-Derived T-Cell Factor and Uses Thereof."

2b. The Examiner requested applicants to update the status of prior applications, which has been done by amendment herein to indicate that the non-provisional parent application 09/189,193 is now U.S. Patent No. 6,184,359.

2c. The Examiner noted that the address of the ATCC needs to be updated, and this has been corrected by amendment herein.

3. Claims 20-25 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner states that claim 20 recites "at least 12 contiguous nucleotides" and states that this language is new matter. Applicants note that a nucleic acid of 12 nucleotides in length is disclosed at page 26, line 27 of the application, as well as page 26, line 31. Thus, the application as filed does disclose the specific limitation "at least 12 contiguous nucleotides." The specification also discloses "18-20 nucleotides" at page 27, line 29. Page 26 of the specification starting at line 18 discloses a broad range of probe lengths: for example, lines 25-29 discloses probes of 14-18 nucleotides in length and possibly as large as the entire sequence of the ETF. This clearly delineates a broad range of lengths and probes of 75 bases are specifically disclosed at line 32 of page 26. Primers of 18-20

nucleotides in length are disclosed at page 27, lines 28-30. This language clearly encompasses the lengths in between including 20-75 nucleotides in length. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

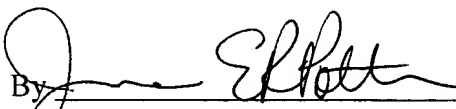
4. Claims 20-30 and 34-35 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Claim 20 is allegedly confusing for stating “in length from SEQ ID NO:1.” The Examiner suggested amending the claim to recite the format including (a), (b), (c) and (d) shown at page 4 of the Office Action, and the applicants have amended claim 20 and claim 28 to conform to the Examiner’s request. Regarding claim 34, the Examiner stated the term “any combination thereof” is vague and indefinite and applicants submit that the claim as amended is not subject to this ground of rejection. In view of the amendments, applicants submit that claims 21-27, 29-30 and 35, which depend from the rejected claims, are not indefinite.

5. Claims 20-22, 26-27, 34 and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Smith et al. (1991). The Examiner states that nucleotides 51-63 of the mouse CRBP1 cDNA are 100% identical to nucleotides 1-13 of SEQ ID NO:1 of the present application. The Examiner concludes that the reference meets the limitations of the nucleic acid of at least 12 contiguous nucleotides in length from SEQ ID NO:1 and anticipates 20-22, 26-27, 34 and 35. Claim 20 as amended is supported by the specification at, for example, page 27, lines 24-28 (“sequences which are highly specific” for the target sequences, and should not form duplexes with other regions of DNA). Applicants submit that in view of the current amendment, which provides for specific binding to nucleic acids of the invention and would therefore exclude the polynucleotide of Smith et al., the rejection may be withdrawn.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

If questions remain regarding this application, the Examiner is invited to contact the undersigned at (206) 628-7650.

Respectfully submitted,
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